REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Claim Amendments

New claims 34 and 35 are added. Support for claim 34 is found in claim 28 prior the amendment which was presented in the submission that accompanied the filing of the RCE on November 18, 2003. Support for claim 35 is found in claim 10. These claims are patentable for at least the same reasons that claims 10 and 28 are patentable.

Rejections Under 35 USC § 102

The rejection of claims 5, 7-14,k 16-20 and 32 under 35 USC § 102(b) as being anticipated by Knowles et al. is respectfully traversed.

In this rejection it is asserted that Knowles et al. discloses each and every feature set forth in the rejected claims. This position is traversed.

In this response, independent claims 5, 11, 20, 25-28 have been amended to call for the claimed steps or logics to be implemented in sequence they are listed in the claims. It is submitted that Knowles et al. neither disclose the claimed sequence of operations nor the nexus which exists therebetweeen. This references therefore cannot be relied upon to anticipate the above-mentioned claims.

In connection with claim 10, it is asserted that just because some of the bar code is not visible due to a shortening technique mentioned at column 17, lines 44-50, it cannot be assumed, under any circumstances, that the remainder is also not visible. In fact, the bar code is always visible wither it contains hidden components or not. The logic that because some of the bar code is hidden that all of the bar code is invisible, is untenable.

Rejections Under 35 USC § 103

The rejection of claims 2-4, 15, 22, 24, 31 and 33 under 35 USC § 103(a) as being unpatentable over Knowles et al, is respectfully traversed.

In order to establish a *prima facie* case of obviousness, it is necessary to show that the hypothetical person of ordinary skill would, without any knowledge of the claimed subject matter and without any inventive activity, be motivated to arrive at the claimed subject matter given the guidance of the cited references when each is fully considered.

The rejection of claim 15 from which claims 2-4 and 31 depend, is traversed. It is initially noted that the rejection is based on "inherency." However, "inherency" can only be applied in the case of anticipation and cannot be used for a rejection advanced under § 103.

This rejection states that:

> "Knowles teaches of "automatically surfing" the web sites
> listed in the URL encoded bar code symbols, as read in
> column 2, line 61 through column 3, line 3. Plus, as seen
> in Fig. 6B, first and second URLs are printed on the
> substrate representing a first communication mode 38 and
> a second, different communication mode 39. Thus, by
> "automatically surfing" the different sites on the sheet, the
> system would **inherently** select the second address when
> the first address is available or unavailable. Also, as read
> in column 18, lines I through 20, and seen in Fig. 9, a
> primary portion and an auxiliary portion of a URL can be
> printed on respective first and second bar code symbols.
> With this, the system would **inherently** produce an error
> message if the second bar code symbol, having only the
> auxiliary portion of a URL, is selected, since the home
> page of the web site cannot be found."

Irrespective of the fact that inherency is not applicable under § 103, it must, in order to be valid, be demonstrated that it will happen in each and every instance and not just in certain circumstances. Further, the selection of the second address "when the first address is available or unavailable" is not clear. Why would the selection of the second address be made if the first was available?

It is also not clear if first and second URLs which are printed on the substrate in fact represent a first communication mode 38 and a second, different communication mode 39. It would appear that the two different URLs would be used in the same mode of communication rather than in different modes. This is particularly relevant in light of the position taken in the anticipation rejection of claims 5, 7-14, 16-20, 25-30 and 32 with respect to WWW information servers and FTP information servers and URL and ZIP codes.

It is submitted that the term "mode", as it is used in the claimed subject matter, is misinterpreted. MPEP 2173.05(a) states that during patent examination, the pending claims must be given the broadest reasonable interpretation **consistent with the specification**. In re Morris, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997); In re Prater, 415 F.2d 1393, 162 USPQ 541 (CCPA 1969). (Emphasis added). Attention is called to the fact that, in the specification, "mode" is exemplified by different transmission techniques such as those including fax machines, e-mail communication, and voice mail communication. The ramifications of this misinterpretation of the claimed term also reflect back to the anticipation rejections.

In addition, and more importantly, it appears that if an error message were to be produced in the purported manner, there would at least be the possibility that the error message would be displayed and an operator left to decide what needs to be done. It cannot be assumed, without teaching disclosure, that the hypothetical person of ordinary skill would be motivated to consider allowing the system to "automatically surf" in the purported manner. This is particularly so in light of the fact that Knowles et al, in every instance, discloses "automatic surfing" in the context of "a programmed bar code symbol scanner for automatically surfing" and that the surfing is to "Web-sites listed in a Web-site guide by simply **scanning** corresponding URL-encoded bar code symbols printed on the pages thereof." (Emphasis added)

This disclosure clearly suggests that the automation is not a separate function and is totally dependent on, and in fact is, a description of the operation of bar code scanner per se. Therefore, it is submitted that the "automatic surfing" feature which the rejection places great reliance and which is repeated throughout the rejection, would not be considered by the hypothetical person of ordinary skill without the simultaneous use of the bar code reader. The extrapolation to a suggestion of selection of possible web sites/addresses in the manner claimed, is not at all supported by this disclosure. Indeed, it would appear that the bar code reader is the very means in the Knowles et al. arrangement via which the "surfing" is "automated."

It is submitted that claims 15, 2-4 and 31 are patentable over Knowles et al. for at least the reasons advanced above.
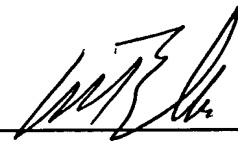
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Conclusion
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It is respectfully submitted that all of the pending claims along with those new added, are allowable over the cited art for at least the reasons advanced above. Favorable reconsideration and allowance of this application is courteously solicited.

Respectfully submitted,

Date: ....*MAY 4*......., 2004   By _____

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